

Remarks

Claims 47-86 are pending. Claims 47-52, 54, 58-59, 63, 65, and 67 are amended to more particularly point out and distinctly claim Applicant's invention.

The Examiner rejected Claim 47 under 35 U.S.C. § 101, stating:

Claim 47 is rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. The non-statutory subject matter is: There is no positive recitation of a step for performing independent physical act (post-computer process activity), or a step for showing a pre-computer process activity. The claim only direct to a method of creating a database with linking instances; therefore, no utility for how this method is used.

The examiner submits that pre-computer and post-computer process activities are required for this claimed method as a utility requirement; see "The PTO Guidelines For Examination Procedures For Computer-Related Invention", published in 1996).

Applicant respectfully submits that the Examiner is in error. Claim 47 recites creating a database in a computer-readable medium:

47. (Currently amended) In a computer-readable medium; a method for providing a database pricing transactions, the method comprising:

creating, in the computer-readable medium, a transaction instance corresponding to a transaction;

creating, in the computer-readable medium, a first production service instance representing an action performed to process said transaction, said first production service instance being linked to said transaction instance by a first relation instance; and

creating, in the computer-readable medium, a billing service instance representing a billing service related to a pricing of said first production service, said billing service

instance being linked to said first production service instance by a second relation instance.

(emphasis added)

According to MPEP § 2106 (IV)(B)(1)(a) such a claim is statutory under 35 U.S.C.

§ 101:

... In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Thus, Applicant requests the Examiner's withdrawal of his rejection under 35 U.S.C.

§ 101 and reconsideration of Claim 47.

The Examiner rejected Claim 47 under 35 U.S.C. § 112, second paragraph, stating:

- The Examiner submits that there is a gap in this claim about how to perform pricing a transaction after a data base is created.

This claim is incomplete, and 35 USC 112, 2nd para. rejection is applied (content of applicant's specification is not used as evidence that the scope of the claims is consistent with the subject matter which applicant regards as his invention).

As amended, Claim 47 now recites "a method for providing a database suitable for pricing transactions." Accordingly, Applicant submits that the Examiner's objection to Claim 47 is overcome.

The Examiner rejected Claims 47-86 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,630,127 ("Moore"), in view of U.S. Patent 5,559,313 ("Claus"), in view of U.S. Patent 5,682,482 ("Burt"), further in view of U.S. Patent 5,636,117 ("Rothstein"). The Examiner states, in section 14:

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Moore et al. ('127) disclose that a rule-based application structure could be a relational database where records of a transaction are related to each other (see Moore, the abstract, Figs.3,4). Moore et al. obviously suggest that: service instances linking to transaction instances; creating a billing service instance linked to a service instance with relation instance (for claim 47), and an entity instance can be an account instance (for claims 64, 85 – for computer programming, please see also Duran et al. U.S. Pat. 5,694,598 wherein account instance is represented as a data list similarly as an entity instance). Moore et al. ('127) obviously suggests a step of storing a transaction instance/an account instance/a client instance, a production service instance, a settlement service instance, and a billing service instance in an entity instance table, and they are inherently “link”/“relate” together as a functional data structure (e.g., see '127 Fig. 4 and col. 10 lines 25-55) (for rejections of claims 48-51, 58, 69-75, 78, 83); (for OO programming using instances, please see also Duran et al. U.S. Pat. 5,694,598).

Burt et al. disclose a support method/system with related function including financial transaction functions (e.g. see Burt et al. '482, the abstract), comprising steps:

- creating a transaction instance corresponding to a financial transaction (e.g. see '482, the abstract, col. 6 lines 1-14, and col. 21 lines 42-59) (for claims 47, 68);

Rothstein ('117) obviously suggests that a market segment instant could be an entity instance (for claim 55) (e.g. see '117 col. 2 lines 8-10, and lines 54-57, col. 3 lines 9-12, please see also Duran et al. (U.S. Pat. 5,694,598) for programming using instance); and

The examiner submits that a price table instance could be defined as a cost table instance (claim 60, 80), and said price could be a cost; or a price table instance could be defined as a fee table instance since price/fee table instance is just a sample instance data structure (for OO programming, please see also Gudmundson et al. (U.S. Pat. 5,680,619), Table V), and said price is a fee (claims 61, 81), whether they are expressed in different terms. The uses of a relational database in cited prior art obviously suggest a step of creating a cost table instance related to a fee table instance by a relation instance (claims 62, 82 – for programming, please see also Gudmundson “Both Elements and Behaviors are “object containers” – in this embodiment, object instances that can “contain” (i.e., be linked to) other object instances. Elements can contain Modifiers as

well as other Elements; and Behaviors can contain Modifiers, including other Behaviors"); and an entity instance can be an account instance (e.g., see also Duran et al., U.S. Pat. 5,94,598 for a use of instance in OOP in a relational database, wherein different programming instances can be linked together).

Claus et al., further express analogous instances in a database (claims 64, 66, 85, and 55), since they are considered as objects in programming:

- an entity instance could be interpreted as a client instance (for OO programming, please see also Gudmundson et al., or Durand et al.);

- an entity instance could be interpreted as a market segment instance (for OO programming, please see also Gudmundson et al., or Durand et al.).

The examiner submits that all claimed limitations are known since events for pricing transactions are recognized as "links" to related objects in computer-related applications, cited prior art's limitations are not necessary spelled-out exactly claimed languages (please see also Duran et al.). It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited prior art disclosures have been described in connection with specific preferred embodiments, it should be understood that their subject matter should not be unduly limited to such specific embodiments.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine specific applications of Moore et al., Burt et al., Rothstein, and Claus et al., in financial transaction with OO programming (in use a relational database) because they all suggest a systematic method to track all of the components of costs and fees each time a financial transaction is processed. It has been recognized that a finance system would be able to measure profitability in a flexible manner and to measure the impact of any changes from banking clients.

In addition, in section 20, the Examiner further states:

... Hence, there is nothing inventive in defining/creating different instances that linking together in a data structure (the

definition is already established for an obvious use of "instance" in cited prior art).

(emphasis in the original)

Applicant respectfully traverses the Examiner's rejection. First, the Examiner's contention regarding what Moore "obviously suggest[s]" is unsupported. The Examiner did not show where in Moore's disclosure is it disclosed or suggested the "service instances," or "billing service instance." In fact, there is none. At col. 3, lines 40-59, Moore discloses that its GRMS system is a risk management system that requires such data as foreign exchange rates, market prices and counter party ratings. Such information is qualitatively different from the "production service instance" and the "billing service instance" recited in Claim 47, which are specific types of instances relating to pricing of a financial transaction:

creating, in the computer-readable medium, a transaction instance corresponding to a transaction;

creating, in the computer-readable medium, a first production service instance representing an action performed to process said transaction, said first production service instance being linked to said transaction instance by a first relation instance; and

creating, in the computer-readable medium, a billing service instance representing a billing service related to a pricing of said first production service, said billing service instance being linked to said first production service instance by a second relation instance.

Further, the Examiner's reliance on Moore's Fig. 4 and col. 10, lines 25-55 to "obviously suggest[s]" production service instance, a settlement service instance and a billing service instance in an entity instance table is also unsupported. Those portions of Moore teach "option_value," "option_exposure" and other data structures relating to currency exchange transactions. Thus, the Examiner's reliance on Moore to teach specific portions of each of Claims 47-51, 58, 59-75, 78 and 83 is erroneous. The Examiner's reliance on U.S.

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not
in claim

Patent 5,694,598 ("Durand") is improper, as Durand is not a reference over which the Examiner rejected any of Claims 47-86 in the first paragraph of section 14.

Similarly, the Examiner's reliance on Rothstein's col. 2, lines 8-10, lines 54-57 and col. 3, lines 9-12 to teach "market segment instance" is also misplaced. As clearly set forth in Rothstein, at col. 2, lines 1-3, Rothstein "provides a technique for monitoring the strength and trends of a real estate market, whether nationally or locally." Thus, Rothstein's disclosure has no bearing on the "market segment instance" of Claim 55, which relates to "a method for providing a database suitable for pricing transactions."

With respect to Claims 60-62 and 80-82, the Examiner simply stated without support that a price table instance could be defined as a cost table instance or a fee table instance. His reliance of U.S. Patent 5,680,619 ("Gudmundson") or Durand is improper, as neither reference is cited by the Examiner in the first paragraph of section 14 as a reference over which any of Claims 47-86 is rejected. At any rate, Gudmundson and Durand each merely teach use of a relational database and provides no teaching relative to price table instances, fee table instances or cost table instances.

With respect to Claims 64, 66, 85 and 55, the Examiner's reliance on Claus "client instance" or "market segment instance" is also unsupported. Claus relates to "a smart card that is responsive to a list of items with individual prices that are received from a point of sale (POS) terminal during the individual transaction to automatically insert these items into expense categories." Thus, Claus too bears no relationship to a database for pricing transaction, which is the subject matter of each of Claims 47-86. The Examiner's references

to Gudmundson and Durand as they pertain to Claus are also improper for the reasons already stated.

Thus, to reject Claims 47-86, the Examiner stitches together a large number of references, each pertaining to a different subject matter and each having no relationship to the subject matters of Claims 47-86 (i.e., database for pricing transactions). The Examiner's cited motivation that "they all suggest a systematic method to track all the components of costs and fees each time a financial transaction is processed" is not found in any of the cited references. Thus, there is no motivation or suggestion in these references to combine their teachings in the manner suggested by the Examiner. In fact, the subject matters cannot be so combined simply because they do not teach the instances the Examiner contends that they teach. Accordingly, Applicant respectfully submits that Claims 47-86 are each allowable over the references of record, whether considered individually or in combination.

For the above reasons, Applicant respectfully submits that the Examiner's rejections of all pending claims (i.e., Claims 47-86) are erroneous. Accordingly, Applicant requests reconsideration and allowance of these claims. If the Examiner has any questions regarding the above, the Examiner is requested to telephone the undersigned Attorney for Applicant at 408-392-9250.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231, on February 6, 2003.



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